

### **REMARKS**

This is a full and timely response to the non-final Office Action of September 6, 2006. Reexamination, reconsideration, and allowance of the application and all presently pending claims are respectfully requested.

Upon entry of this First Response, claims 1-8, 11-18, and 21-25 remain pending in this application. Claims 6-8, 11, 18, and 23 are allowed, and claims 1, 4, 21, 22, and 24 are directly amended herein. It is believed that the foregoing amendments add no new matter to the present application.

### **Claim to Priority**

It is alleged in the outstanding Office Action that a claim to priority of U.S. Patent No. 6,622,238 is not included in the first sentence(s) of the specification. Applicants respectfully submit that an amendment to insert a claim of priority to U.S. Patent No. 6,622,238 was requested by Applicants on page 1 of the Request for a Continuing Application Under 37 C.F.R. 1.53(b), which was filed with the Patent Office on August 27, 2003. Based on the comments in the Office Action, Applicants assume that the amendment has not been entered. Accordingly, via the amendments set forth herein, Applicants have amended the specification to include a reference to U.S. Patent No. 6,622,238. Since a reference to U.S. Patent No. 6,622,238 was included in the Request for a Continuing Application Under 37 C.F.R. 1.53(b) and it appears that the Patent Office has recognized the claim to priority, Applicants believe that a petition under 37 C.F.R. 1.78(a) is not required. See M.P.E.P. §201.11.

### **Specification**

It is alleged in the Office Action that the title of the invention is not descriptive. Applicants respectfully disagree. Nevertheless, in an effort to comply with requirements in the Office Action, Applicants have amended the title.

### **Response to Double Patenting Rejections**

Claims 1-5, 12-17, 21, 22, 24, and 25 are rejected on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 1-6 and 13-17 of U.S. Patent No. 6,622,238. Submitted herewith is a terminal disclaimer pertaining to U.S. Patent No. 6,622,238, and Applicants, therefore, request that the double patenting rejections of claims 1-5, 12-17, 21, 22, 24, and 25 be withdrawn. See M.P.E.P. §804.02.

In filing the terminal disclaimer, Applicants rely upon the rulings of the Federal Circuit that the filing of such a terminal disclaimer does not act as an admission, acquiescence or estoppel on the merits of the obviousness issue. "In legal principle, the filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither presumption nor estoppel on the merits of the rejection." *Quad Environmental Tech. v. Union Sanitary Dist.*, 946 F.2d 870, 874 (Fed. Cir. 1991); *Ortho Pharmaceutical Corp. v. Smith*, 959 F.2d 936, 941-942 (Fed. Cir. 1992).

### **Response to §102 Rejections**

A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior art reference disclose each element of the claim. See, e.g., *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983).

### Claim 1

Claim 1 presently stands rejected under 35 U.S.C. §102 as allegedly being anticipated by *Arora* (U.S. Patent No. 6,442,678). Claim 1, as amended, reads as follows:

1. A computer system for processing instructions of computer programs, comprising:
  - a register;
  - a pipeline configured to execute instructions of a computer program, said pipeline having a first stage and a second stage;
  - first circuitry configured to read a first predicate value from said register and to receive a second predicate value, said first circuitry configured to select between at least said second predicate value and said first predicate value read from said register, said first circuitry further configured to transmit, to said first stage, the value selected by said first circuitry; and
  - second circuitry configured to select between at least a third predicate value and said value selected by said first circuitry, said second circuitry further configured to transmit, to said second stage, the value selected by said second circuitry.*** (Emphasis added).

Applicants respectfully assert that *Arora* fails to disclose at least the features of claim 1 highlighted above.

In this regard, it is apparently alleged in the Office Action that elements 111-113 of *Arora* constitute the recited “circuitry” that selects between a “first predicate value” and a “second predicate value.” However, *Arora* fails to disclose “second circuitry” that is configured to select between a “third predicate value” and any of the values selected by elements 111-113. Thus, *Arora* fails to disclose “***second circuitry configured to select between at least a third predicate value and said value selected by said first circuitry, said second circuitry further configured to transmit, to said second stage, the value selected by said second circuitry,***” as recited by claim 1. (Emphasis added).

For at least the above reasons, Applicants respectfully submit that the cited art fails to disclose each feature of pending claim 1. Accordingly, the 35 U.S.C. §102 rejection of claim 1 should be withdrawn.

### **Claims 2, 3, and 5**

Claims 2, 3, and 5 presently stand rejected in the Office Action under 35 U.S.C. §102 as allegedly being anticipated by *Arora*. Applicants submit that the pending dependent claims 2, 3, and 5 contain all features of their respective independent claim 1. Since claim 1 should be allowed, as argued hereinabove, pending dependent claims 2, 3, and 5 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

### **Claim 24**

Claim 24 presently stands rejected under 35 U.S.C. §102 as allegedly being anticipated by *Arora*. Claim 24, as amended, reads as follows:

24. A system for processing instructions of computer programs, comprising:  
a pipeline configured to execute an instruction of a computer program, said pipeline having a first stage and a second stage;  
first circuitry configured to read a first predicate value from a register and to select one predicate value among a first plurality of predicate values, said first plurality of predicate values including said first predicate value read from said register, said first circuitry further configured to transmit, to said first stage, the value selected by said first circuitry; and  
***second circuitry configured to receive, from said first circuitry, said value selected by said first circuitry, said second circuitry configured to select one predicate value among a second plurality of predicate values, said second plurality of predicate values including said value selected by said first circuitry, said second circuitry further configured to transmit, to said second stage, the value selected by said second circuitry,***  
wherein said first stage is configured to process said instruction based on said first predicate value transmitted to said first stage, and wherein said second stage is configured to process said instruction based on said selected predicate value. (Emphasis added).

For at least reasons similar to those set forth above in the arguments for allowance of claim 1, Applicants respectfully assert that *Arora* fails to disclose at least the features of claim 24 highlighted above. Accordingly, the 35 U.S.C. §102 rejection of claim 24 should be withdrawn.

### **Claim 25**

Claim 25 presently stands rejected in the Office Action under 35 U.S.C. §102 as allegedly being anticipated by *Arora*. Applicants submit that the pending dependent claim 25 contains all features of its independent claim 24. Since claim 24 should be allowed, as argued hereinabove, pending dependent claim 25 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

### **Allowable Subject Matter**

Claims 4, 21, and 22 have been indicated as allowable by the outstanding Office Action if such claims are rewritten to include the limitations of their respective base claims and if the double patenting rejections of these claims are overcome. Accordingly, pending claims 4, 21, and 22 have been amended herein to include the features of their respective base claims, and Applicants submit that the double patenting rejections of these claims should be withdrawn in view of the terminal disclaimer submitted herewith. Accordingly, Applicants respectfully request that claims 4, 21, and 22 be allowed in the next action from the Patent Office.


### **CONCLUSION**

Applicants respectfully request that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding Applicants' response, the Examiner is encouraged to telephone Applicants' undersigned counsel.

Respectfully submitted,

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